

09/509428  
430 Rec'd PCT/PTO 28 MAR 2000

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: ) PATENT  
Mats LEIJON et al. )  
Serial No: New Application ) Group: To Be Assigned  
Based on PCT/SE98/01738 )  
Filed: March 28, 2000 ) Examiner: To Be Assigned  
AN ELECTRIC POWER )  
PLANT )

#6  
T. Anderson  
11-21-00

**INFORMATION DISCLOSURE STATEMENT**  
**SUBMITTED WITHOUT COPIES OF INFORMATION**  
**DISCLOSURE STATEMENT CITATIONS PURSUANT TO**  
**DECISION ON PETITION UNDER 37 C.F.R. 1.183**  
**SEEKING WAIVER OF REQUIREMENTS UNDER 37**  
**C.F.R. 1.98**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Washington, D.C.  
March 28, 2000

Sir:

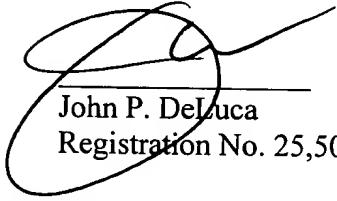
Pursuant to 37 C.F.R. §1.56, the attention of the Patent and Trademark Office is hereby directed to the reference(s) listed on the attached PTO Form-1449. Copies of the references were filed in the office of Examiner Gelner with a petition dated September 27, 1999.

The above information is presented so that the Patent and Trademark Office may, in the first instance, determine any materiality thereof to the claimed invention. See 37 C.F.R. §§1.104(a) and 1.106(b) concerning the PTO duty to consider and use any such information. It is respectfully requested that the information be expressly considered during the prosecution of this application, and that the reference(s) be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

Pursuant to the Decision on Petition dated December 1, 1999, which was filed in U.S. Patent Application No.09/147,325 (the holding application),

If additional fees are required, please charge Deposit Account No.23-0575.

Respectfully submitted,

  
John P. DeLuca  
Registration No. 25,505

WATSON COLE GRINDLE WATSON  
1400 K Street, N.W., 10<sup>th</sup> Floor  
Washington, D.C. 20005-2477  
(202) 628-3600  
JPD/er

INFORMATION DISCLOSURE CITATION LIST ALTERNATE FORM PTO-1449		Docket Number:	Application Number
			09/509428
Issue 2: dated 02/21/00		Applicant(s):	
		Filing Date:	Group Art Unit:

## U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
1		US 4,292,558	9/29/1981	Carl Flick et al			
2		US 4,656,316	4/7/1987	Hans-Juergen Meltsch			
3							
4							
5							
6							
7							
8							
9							
10							
11							
12							
13							
14							
15							
16							
17							
18							
19							
20							
21							
22							
23							
24							
25							
26							
27							
28							
29							
30							
31							
32							
33							
34							
35							
36							
37							
38							
39							

Subtotal							
----------	--	--	--	--	--	--	--

Examiner	Date Considered
*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEPO 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	

FORMATION DISCLOSURE CITATION  
ALTERNATE FORM PTO-144909/509428  
Issue2, dated 02/21/00

## FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION
					YES      NO
1		GB 1,319,257	6/6/1973	Anders R. Andersson et al	
2		GB 1,322,433	7/4/1973	Siemens Aktiengesellschaft	
3		GB 2,070,341	9/3/1981	Hans-Georg Raschbichler et al	
4		WO 98/20598	5/14/1998	Jan-Anders Karlfeldtsgatan et al	
5		WO 98/20602	5/14/1998	Soren Berggren	
6		WO 98/34239	8/6/1998	Gunnar Steneorpsgatan et al	
7		WO 99/28922	6/10/1999	Thorsten Schutte et al	
8		WO 99/29005	6/10/1999	Mats Leijon et al	
9		WO 99/29023	6/10/1999	Peter Carstensen et al	
10		WO 99/29025	6/10/1999	Mats Leijon et al	
11		EP 0056580 A1	7/28/1982	Jacobus F.H. Van der Vegt	
12					
13					
14					
15					
16					
17					
18					
19					
20					
21					
22					
23					
24					
25					
26					
27					
28					
29					
30					
31					
32					
33					
34					
35					
36					
37					
38					
39					
40					
41					
42					

Subtotal					
----------	--	--	--	--	--

Examiner	Date Considered
----------	-----------------

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

INFORMATION DISCLOSURE CITATION LIST ALTERNATE FORM PTO-89 (Corrected Listing of Original List)		Docket Number:	Application Number
		Applicant(s):	
		Filing Date:	Group Art Unit:

## U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
1	US1304451	5/20/19	L. H. Burnham			
2	US1418856	6/2/22	Robert B. Williamson			
3	US1481585	1/22/24	James Robert Beard			
4	US1728915	9/24/29	E. P. Blankenship et al			
5	US1742985	1/7/30	L. H. Burnham			
6	US1747507	2/18/30	Robert B. George			
7	US1756672	4/29/30	John M. Barr			
8	US1762775	6/10/30	Albert G. Ganz			
9	US1781308	11/11/30	Mauritz Vos			
10	US1861182	5/31/32	F. Hendey et al			
11	US1974406	9/25/34	Vincent G. Apple et al			
12	US2006170	6/25/35	Gustof A. Juhlin			
13	US2206856	7/2/40	W. E. Shearer			
14	US2217430	10/8/40	R. A. Baudry			
15	US2241832	5/13/41	H.W. Wahlquist			
16	US2251291	8/5/41	L. O. Reichelt			
17	US2256897	9/23/41	W. F. Davidson et al			
18	US2295415	9/8/42	G.R. Monroe			
19	US2415652	2/11/47	R. B. Norton			
20	US2424443	7/22/47	B. C. Evans			
21	US2436306	2/17/48	J. S. Johnson			
22	US2446999	8/17/48	G. Camilli			
23	US2459322	1/18/49	G. T. Johnston			
24	US2462651	2/22/49	H. W. Lord			
25	US2498238	2/21/50	L. J. Berberich et al			
26	US2721905	10/25/55	D. J. Monroe			
27	US2780771	2/5/57	B. Lee			
28	US2846599	8/5/58	H. H. McAdam			
29	US2885581	5/5/59	P. T. Pileggi			
30	US2943242	6/28/60	E. Schaschl et al			
31	US2947957	8/2/60	J. C. Spindler			
32	US2959699	11/8/60	J. W. Smith et al			
33	US2962679	11/29/60	J. L. Stratton			
34	US2975309	3/14/61	M. Seidner			
35	US3098893	7/23/63	R. A. Pringle et al			
36	US3130335	4/21/64	L. J. Rejda			
37	US3143269	8/4/64	J. Van Eldik			
38	US3157806	11/17/64	E. Wiedemann			
39	US3158770	11/24/64	A. D. Coggeshall et al			
40	US3268766	8/23/66	S. E. Amos			
41	US3304599	2/21/67	R. W/ Nordin			
42	US3354331	11/21/67	H. L. Broeker et al			
43	US3365657	1/23/68	James Webb			
44	US3372283	5/5/68	A. A. Jaecklin			

Examiner

Date

Considered

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

**ALTERNATE FORM PTO-1449**  
**(Corrected Listing of Original List)**

45	US3418530	11/24/68	W. H. Cheever		
46	US3435262	3/25/69	R. B. Bennett et al		
47	US3437858	4/8/69	R. B. White		
48	US3444407	5/13/69	E.S. Yates		
49	US3447002	5/27/69	C. Ronnevig		
50	US3484690	12/16/69	H. Wald		
51	US3560777	2/2/71	W. Moeller		
52	US3593123	7/13/71	A. C . Williamson		
53	US3631519	12/28/71	H. Salahshourian		
54	US3644662	2/22/72	H. Salahshourian		
55	US3651402	3/21/72	P. H. Leffmann		
56	US3670192	6/13/72	A. A. Andersson et al		
57	US3675056	7/4/72	H. G. Lenz		
58	US3684821	8/15/72	M. Miyauchi et al		
59	US3716652	2/13/73	G. E. Lusk et al		
60	US3716719	2/13/73	H. W. Angelery et al		
61	US3727085	4/10/73	P. B. Goetz et al		
62	US3740600	6/19/73	B. Turley		
63	US3746954	7/17/73	A. Myles set al		
64	US3758699	9/11/73	G. Lusk et al		
65	US3778891	12/18/73	R. Amasino et al		
66	US3781739	12/25/73	L. Meyer		
67	US3792399	2/17/74	W. McLyman		
68	US3801843	4/2/74	J. Corman et al		
69	US3809933	5/7/74	H. Sugawara et al		
70	US3881647	5/6/75	B. Wolfe		
71	US3884154	5/20/75	F. Marten		
72	US3891880	6/24/75	H. Britsch		
73	US3902000	8/26/75	E. Forsyth et al		
74	US3932779	1/13/76	A. Madsen		
75	US3932791	1/13/76	J. Oswald		
76	US3943392	3/9/76	J. Keuper et al		
77	US3947278	3/30/76	K. Youtsey		
78	US3965408	6/22/76	H. Higuchi et al		
79	US3968388	7/6/76	D. Lambrecht et al		
80	US3971543	7/27/76	W. Shanahan		
81	US3974314	8/10/76	H. Fuchs		
82	US3995785	12/7/76	R. Arick et al		
83	US4001616	1/4/77	P. Lonseth et al		
84	US4008409	2/15/77	R. Rhudy et al		
85	US4031310	6/21/77	L. Jachimowicz		
86	US4039740	8/2/77	Z. Iwata		
87	US4041431	8/9/77	G. Enoksen		
88	US4047138	9/6/77	R. Steigerwald		
89	US4064419	12/20/77	R. Peterson		
90	US4084307	4/18/78	G. Schultz el al		
91	US4085347	4/18/78	K. Lichius		
92	US4088953	5/9/78	S. Sarian		
93	US4091138	5/23/78	Takagi et al		
94	US4091139	5/23/78	J. Quirk		
95	US4099227	7/4/78	J. Liptak		

Examiner

Date  
Considered

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

**ALTERNATE FORM PTO-1449**  
**(Corrected Listing of Original List)**

96	US4103075	7/25/78	E. Adam			
97	US4106069	8/8/78	J. Trautner et al			
98	US4107092	8/15/78	R. Carnahan et al			
99	US4109098	8/22/78	M. Olsson et al			
100	US4121148	10/17/78	H. Platzer			
101	US4134036	1/9/79	G. Curtiss			
102	US4134055	1/9/79	M. Akamatsu			
103	US4134146	1/9/79	E. Stetson			
104	US4149101	4/10/79	A. Lesokhin et al			
105	US4152615	5/1/79	R. Calfo et al			
106	US4160193	7/3/79	A. Richmond			
107	US4164672	8/14/79	C. Flick			
108	US4164772	8/14/79	N. Hingorani			
109	US4177397	12/4/79	John Lill			
110	US4177418	12/4/79	K. Brueckner et al			
111	US4184186	1/15/80	P. Barkan			
112	US4200817	4/29/80	T. Bratoljic			
113	US4200818	4/29/80	C. Ruffing et al			
114	US4206434	6/3/80	A. Hase			
115	US4207427	6/10/80	G. Beretta et al			
116	US4207482	6/10/80	C. Neumeyer et al			
117	US4208597	6/17/80	A. Mulach et al			
118	US4229721	10/21/80	W. Koloczek et al			
119	US4238339	12/9/80	G. Khutoretsky et al			
120	US4239999	12/16/80	A. Vinokurov et al			
121	US4245182	1/13/81	H. Aotsu et al			
122	US4246694	1/27/81	H-G Raschbichler et al			
123	US4255684	3/10/81	W. Mischler et al			
124	US4258280	3/24/81	M. Starcevic			
125	US4262209	4/14/81	C. Berner			
126	US4274027	6/16/81	S. Higuchi et al			
127	US4281264	7/28/81	T. Keim et al			
128	US4307311	12/22/81	A. Grozinger			
129	US4308476	12/29/81	R. Schuler			
130	US4308575	12/29/81	A. Mase			
131	US4310966	1/19/82	O. Brietenbach			
132	US4317001	2/23/82	D. Silver et al			
133	US4320645	3/23/82	L. Stanley			
134	US4321518	3/23/82	M. Akamatsu			
135	US4330726	5/18/82	D. Albright et al			
136	US4337922	7/6/82	M. Streiff et al			
137	US4341989	7/27/82	T. Sandberg et al			
138	US4347449	8/31/82	J. F. Beau			
139	US4347454	8/31/82	K. Gellert et al			
140	US4363612	10/12/82	R. Meyers			
141	US4357542	11/2/82	H. Kirschbaum			
142	US4360748	11/23/82	H-G Raschbichler et al			
143	US4367425	1/4/83	M. Mendelsohn et al			
144	US4368418	1/11/83	F. P. Demello et al			
145	US4369389	1/18/83	D. Lambrecht			
146	US4371745	2/1/83	M. Sakashita			

Examiner

Date  
Considered

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEPO 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

**ALTERNATE FORM PTO-1449**  
 (Corrected Listing of Original List)

	147	US4387316	6/7/83	J. Katsekas			
	148	US4403163	9/6/83	Rammerding et al			
	149	US4404486	9/13/83	T. Keim et al			
	150	US4411710	10/25/83	M.Mochizuki et al			
	151	US4421284	12/20/83	A. Pan			
	152	US4425521	1/10/84	G. Rosenberry, Jr. et al			
	153	US4426771	1/24/84	D. Wang et al			
	154	US4429244	1/31/84	P. Nikiten et al			
	155	US4431960	2/14/84	O. Zucker			
	156	US4443725	4/17/84	S. Derderian et al			
	157	US4470884	9/11/84	D. Carr			
	158	US4473765	9/25/84	T. Butman, Jr. et al			
	159	US4475075	10/2/84	R. Munn			
	160	US4477690	10/16/84	P. Nikitin et al			
	161	US4481438	11/6/84	T. Keim			
	162	US4488079	12/11/84	G. Dailey et al			
	163	US4503284	3/5/95	M. Minnick et al			
	164	US4510077	4/9/85	R. Elton			
	165	US4517471	5/14/85	K. Sachs			
	166	US4523249	6/11/85	S. Arimoto			
	167	US4538131	8/27/85	M. Baier et al			
	168	US4546210	10/8/85	Y. Akiba et al			
	169	US4551780	11/5/85	M. Canay			
	170	US4557038	12/10/85	M. Wcislo et al			
	171	US4560896	12/24/85	G. Vogt et al			
	172	US4565929	1/21/86	J. Baskin et al			
	173	US4588916	5/13/86	R. Lis			
	174	US4590416	5/20/86	M. Porche et al			
	175	US4594630	6/10/86	M. Rabinowitz et al			
	176	US4607183	8/19/86	J. Rieber et al			
	177	US4615109	10/7/86	M. Wcislo et al			
	178	US4618795	10/21/86	G. Cooper et al			
	179	US4619040	10/28/86	D. Wang et al			
	180	US4633109	12/30/86	J. Feigel			
	181	US4650924	3/17/87	J. Kauffman et al			
	182	US4656379	4/7/87	F. McCarty			
	183	US4677328	6/30/87	K. Kumakura			
	184	US4687882	8/18/87	G. Stone et al			
	185	US4692731	9/8/87	H. Osinga			
	186	US4723104	2/22/88	F. Rohatyn			
	187	US4737704	4/12/88	S. Kalinnikov et al			
	188	US4745314	5/17/88	J. Nakano			
	189	US4766365	8/23/88	L. Bolduc et al			
	190	US4785138	11/15/88	O. Brietenbach et al			
	191	US4795933	1/3/89	K. Sakai			
	192	US4827172	5/2/89	K. Kobayashi			
	193	US4845308	7/4/89	E. Womack, Jr. et al			
	194	US4847747	7/11/89	A. Abbondanti			
	195	US4853565	8/1/89	R. Elton et al			
	196	US4859810	8/22/89	R. Cloetens et al			
	197	US4860430	8/29/89	H. Raschbichler et al			

Examiner

Date  
Considered

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEPO 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

**ALTERNATE FORM PTO-1449**  
**(Corrected Listing of Original List)**

198	US4864266	9/5/89	L. Feather et al			
199	US4883230	11/28/89	L. Lindstrom			
200	US4894284	1/16/90	S. Yamanouchi et al			
201	US4914386	4/3/90	S. Zocholl			
202	US4918347	4/17/90	Y. Takaba			
203	US4918835	4/24/90	H. Wcislo et al			
204	US4924342	5/8/90	R. Lee			
205	US4926079	5/15/90	P. Niemela et al			
206	US4942326	7/17/90	J. Butler, III et al			
207	US4949001	8/14/90	S. Campbell			
208	US4994952	2/19/91	D. Silva et al			
209	US4997995	3/5/91	M. Simmons et al			
210	US5012125	4/30/91	D. Conway			
211	US5036165	7/30/91	R. Elton et al			
212	US5036238	7/30/91	M. Tajima			
213	US5066881	11/19/91	R. Elton et al			
214	US5067046	11/19/91	R. Elton et al			
215	US5083360	1/28/92	M. Valencic et al			
216	US5086246	2/4/92	J. Dymond et al			
217	US5094703	3/10/92	M. Takaoka et al			
218	US5097241	3/17/92	E. Smith et al			
219	US5097591	3/24/92	M. Wcislo et al			
220	US5111095	5/5/92	J. Hendershot			
221	US5124607	6/23/92	J. Rieber et al			
222	US5136459	8/4/92	D. Fararooy			
223	US5140290	8/18/92	H. Dersch			
224	US5153460	10/6/92	L. Bovino et al			
225	US5168662	12/8/92	K. Nakamura et al			
226	US5187428	2/16/93	R. Hutchison et al			
227	US5235488	8/10/93	S. Koch			
228	US5246783	9/21/93	L. Spenadel et al			
229	US5264778	11/23/93	D. Kimmel et al			
230	US5304883	4/19/93	J. Denk			
231	US5305961	4/26/93	A. Errard et al			
232	US5321308	6/14/93	A. Johncock			
233	US5323330	6/21/93	G. Asplund et al			
234	US5325008	6/28/94	J. Grant			
235	US5327637	7/12/94	O. Britenbach et al			
236	US5341281	8/23/94	G. Skibinski			
237	US5343139	8/30/94	L. Gyugyi et al			
238	US5355046	10/11/94	K. Weigelt			
239	US5365132	11/15/94	J. Hann et al			
240	US5387890	2/7/95	P. Estop et al			
241	US5397513	3/14/95	C. Steketee, Jr.			
242	US5400005	3/21/95	H. Bobry			
243	US5452170	9/19/95	S. Ohde et al			
244	US5468916	11/21/95	M. Litenas et al			
245	US5500632	3/19/96	J. Halser, III			
246	US5510942	4/23/96	L. Bock et al			
247	US5530307	6/25/96	G. Horst			
248	US5545853	8/13/96	N. Hildreth			

Examiner

Date

Considered

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

**ALTERNATE FORM PTO-1449**  
**(Corrected Listing of Original List)**

249	US5550410	8/27/96	C. Titus		
250	US5583387	12/10/96	M. Takeuchi et al		
251	US5587126	12/24/96	C. Steketee, Jr.		
252	US5598137	1/28/97	F. Alber et al		
253	US5607320	3/4/97	J. Wright		
254	US5612510	3/18/97	N. Hildreth		
255	US5663605	9/2/97	P. Evans et al		
256	US5672926	9/30/97	J. Brandes et al		
257	US5689223	11/18/97	A Demarmels et al		
258	US5807447	9/15/98	I. Forrest		
259	US681800	9/3/01	O. Lasche		
<b>Subtotal:</b>	<b>*259</b>				

**FOREIGN PATENT DOCUMENTS**

	DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION	
				YES	NO
1	AT399790	7/25/95	Austria		
2	BE565063	2/23/57	Belgium		
3	CH391071	4/30/65	Switzerland		
4	CH534448	2/28/73	Switzerland		
5	CH539328	7/4/73	Switzerland		
6	CH657482	8/29/86	Switzerland		
7	DD137164	8/15/79	Germany DDR		
8	DD138840	11/21/79	Germany DDR		
9	DE1638176	6/24/71	Germany		
10	DE1807391	5/27/70	Germany		
11	DE2050674	5/19/71	Germany		
12	DE2155371	5/17/73	Germany		
13	DE2400698	7/10/75	Germany		
14	DE2520511	11/18/76	Germany		
15	DE2656389	6/15/78	Germany		
16	DE2721905	11/23/78	Germany		
17	DE277012	7/25/14	Germany		
18	DE19547229	6/19/97	Germany		
19	DE2824951	12/20/79	Germany		
20	DE2835386	2/21/80	Germany		
21	DE2839517	3/27/80	Germany		
22	DE2854520	6/26/80	Germany		
23	DE2913697	10/16/80	Germany		
24	DE2917717	8/20/87	Germany		
25	DE2920478	12/4/80	Germany		
26	DE2939004	4/9/81	Germany		
27	DE3006382	8/27/81	Germany		
28	DE3008818	9/10/81	Germany		
29	DE3009102	9/25/80	Germany		
30	DE3028777	3/26/81	Germany		
31	DE3305225	8/16/84	Germany		
32	DE3309051	9/20/84	Germany		
33	DE336418	6/23/20	Germany		
34	DE3441311	5/15/86	Germany		

Examiner

Date

Considered

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

**ALTERNATE FORM PTO-1449**  
**(Corrected Listing of Original List)**

35	DE3543106	6/11/87	Germany		
36	DE3612112	10/15/87	Germany		
37	DE372390	3/27/23	Germany		
38	DE3726346	2/16/89	Germany		
39	DE387973	1/9/24	Germany		
40	DE4022476	1/16/92	Germany		
41	DE4023903	11/7/91	Germany		
42	DE40414	8/15/1887	Germany		
43	DE4233558	3/31/94	Germany		
44	DE425551	2/20/26	Germany		
45	DE426793	3/18/26	Germany		
46	DE432169	7/26/26	Germany		
47	DE433749	9/7/26	Germany		
48	DE435608	10/18/26	Germany		
49	DE435609	10/18/26	Germany		
50	DE4409794	8/24/95	Germany		
51	DE4412761	10/26/95	Germany		
52	DE441717	3/11/27	Germany		
53	DE4420322	12/14/95	Germany		
54	DE443011	4/13/27	Germany		
55	DE460124	5/22/28	Germany		
56	DE482506	9/14/29	Germany		
57	DE501181	7/3/30	Germany		
58	DE523047	4/18/31	Germany		
59	DE568508	1/20/33	Germany		
60	DE572030	3/9/33	Germany		
61	DE584639	9/27/33	Germany		
62	DE586121	10/18/33	Germany		
63	DE604972	11/6/34	Germany		
64	DE629301	4/27/36	Germany		
65	DE673545	3/24/39	Germany		
66	DE719009	3/26/42	Germany		
67	DE846583	8/14/52	Germany		
68	DE875227	4/30/53	Germany		
69	EP0120154	10/3/84	European		
70	EP0130124	1/2/85	European		
71	EP0142813	5/29/85	European		
72	EP0155405	9/25/85	European		
73	EP0174783	3/19/86	European		
74	EP0234521	9/2/87	European		
75	EP0244069	11/4/87	European		
76	EP0246377	11/25/87	European		
77	EP0265868	5/4/88	European		
78	EP0274691	7/20/88	European		
79	EP0280759	9/7/88	European		
80	EP0282876	9/21/88	European		
81	EP0309096	3/29/89	European		
82	EP0314860	5/10/89	European		
83	EP0316911	5/24/89	European		
84	EP0317248	5/24/89	European		
85	EP0335430	10/4/89	European		

Examiner

Date

Considered

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

**ALTERNATE FORM PTO-1449**  
**(Corrected Listing of Original List)**

86	EP0342554	11/23/89	European		
87	EP0375101	6/27/90	European		
88	EP0406437	1/9/91	European		
89	EP0439410	7/31/91	European		
90	EP0440865	8/14/91	European		
91	EP0490705	6/17/92	European		
92	EP049104	4/7/82	European		
93	EP0493704	4/7/82	European		
94	EP0571155	11/24/93	European		
95	EP0620570	10/19/94	European		
96	EP0642027	3/8/95	European		
97	EP0671632	9/13/95	European		
98	EP0676777	10/11/95	European		
99	EP0677915	10/18/95	European		
100	EP0684679	11/29/95	European		
101	EP0684682	11/29/95	European		
102	EP0695019	1/31/96	European		
103	EP0732787	9/18/96	European		
104	EP0738034	10/16/96	European		
105	EP0740315	10/30/96	European		
106	EP0751605	1/2/97	European		
107	EP0780926	6/25/97	European		
108	EP078908	5/18/83	European		
109	EP0802542	10/22/97	European		
110	FR1011924	4/23/49	France		
111	FR1126975	3/11/55	France		
112	FR1238795	7/6/59	France		
113	FR2108171	5/19/72	France		
114	FR2251938	6/13/75	France		
115	FR2305879	10/22/76	France		
116	FR2376542	7/28/78	France		
117	FR2467502	4/17/81	France		
118	FR2556146	6/7/85	France		
119	FR2594271	8/14/87	France		
120	FR2708157	1/27/95	France		
121	FR805544	4/29/36	France		
122	FR841351	1/19/38	France		
123	FR847899	12/22/38	France		
124	GB1024583	3/30/66	United Kingdom		
125	GB1053337	12/30/66	United Kingdom		
126	GB1059123	2/15/67	United Kingdom		
127	GB1103098	2/14/68	United Kingdom		
128	GB1103099	2/14/68	United Kingdom		
129	GB1117401	6/19/68	United Kingdom		
130	GB1135242	12/4/68	United Kingdom		
131	GB1147049	4/2/69	United Kingdom		
132	GB1157885	7/9/69	United Kingdom		
133	GB1174659	12/17/69	United Kingdom		
134	GB1236082	6/16/71	United Kingdom		
135	GB123906	3/13/19	United Kingdom		
136	GB1268770	3/29/72	United Kingdom		

Examiner

Date  
Considered

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

**ALTERNATE FORM PTO-1449**  
**(Corrected Listing of Original List)**

	137	GB1340983	12/19/73	United Kingdom		
	138	GB1341050	12/19/73	United Kingdom		
	139	GB1365191	8/29/74	United Kingdom		
	140	GB1395152	5/21/75	United Kingdom		
	141	GB1424982	2/11/76	United Kingdom		
	142	GB1426594	3/3/76	United Kingdom		
	143	GB1438610	6/9/76	United Kingdom		
	144	GB1445284	8/11/76	United Kingdom		
	145	GB1479904	7/13/77	United Kingdom		
	146	GB1493163	11/23/77	United Kingdom		
	147	GB1502938	3/8/78	United Kingdom		
	148	GB1525745	9/20/78	United Kingdom		
	149	GB1548633	7/18/79	United Kingdom		
	150	GB1574796	9/10/80	United Kingdom		
	151	GB2000625	1/10/79	United Kingdom		
	152	GB2022327	12/12/79	United Kingdom		
	153	GB2025150	1/16/80	United Kingdom		
	154	GB2034101	5/29/80	United Kingdom		
	155	GB2046142	11/12/79	United Kingdom		
	156	GB2070470	9/8/81	United Kingdom		
	157	GB2071433	9/16/81	United Kingdom		
	158	GB2081523	2/17/82	United Kingdom		
	159	GB2099635	12/8/82	United Kingdom		
	160	GB2105925	3/30/83	United Kingdom		
	161	GB2106306	4/7/83	United Kingdom		
	162	GB2106721	4/13/83	United Kingdom		
	163	GB2136214	9/12/84	United Kingdom		
	164	GB2140195	11/21/84	United Kingdom		
	165	GB2268337	1/5/94	United Kingdom		
	166	GB2273819	6/29/94	United Kingdom		
	167	GB2283133	4/26/95	United Kingdom		
	168	GB2289992	12/6/95	United Kingdom		
	169	GB2308490	6/25/97	United Kingdom		
	170	GB268271	3/31/27	United Kingdom		
	171	GB292999	4/11/29	United Kingdom		
	172	GB293861	11/8/28	United Kingdom		
	173	GB319313	7/18/29	United Kingdom		
	174	GB518993	3/13/40	United Kingdom		
	175	GB537609	6/30/41	United Kingdom		
	176	GB540456	10/17/41	United Kingdom		
	177	GB589071	6/11/47	United Kingdom		
	178	GB685416	1/7/53	United Kingdom		
	179	GB702892	1/27/54	United Kingdom		
	180	GB715226	9/8/54	United Kingdom		
	181	GB723457	2/9/55	United Kingdom		
	182	GB763761	12/19/56	United Kingdom		
	183	GB805721	12/10/58	United Kingdom		
	184	GB827600	2/10/60	United Kingdom		
	185	GB854728	11/23/60	United Kingdom		
	186	GB870583	6/14/61	United Kingdom		
	187	GB913386	12/19/62	United Kingdom		

Examiner

Date

Considered

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

**ALTERNATE FORM PTO-1449**  
**(Corrected Listing of Original List)**

188	GB965741	8/6/64	United Kingdom		
189	GB992249	5/19/65	United Kingdom		
190	JP424909	1/28/92	Japan		
191	JP1129737	5/23/89	Japan		
192	JP318253	1/25/91	Japan		
193	JP3245748	2/23/90	Japan		
194	JP4179107	11/9/90	Japan		
195	JP5290947	4/8/92	Japan		
196	JP57043529	8/29/80	Japan		
197	JP59076156	10/25/82	Japan		
198	JP59159642	2/28/83	Japan		
199	JP60206121	3/30/59	Japan		
200	JP6196343	12/22/92	Japan		
201	JP6233442	2/4/93	Japan		
202	JP6264964	9/18/85	Japan		
203	JP6325629	5/10/93	Japan		
204	JP7057951	8/19/93	Japan		
205	JP7264789	3/22/94	Japan		
206	JP8167332	12/13/94	Japan		
207	JP8264039	11/1/95	Japan		
208	JP9200989	1/17/96	Japan		
209	LU67199	3/14/72	Luxembourg		
210	SE255156	2/25/69	Sweden		
211	SE305899	11/11/68	Sweden		
212	SE341428	12/27/71	Sweden		
213	SE453236	1/20/82	Sweden		
214	SE457792	6/12/87	Sweden		
215	SE502417	12/29/93	Sweden		
216	SE90308	9/21/37	Sweden		
217	SU1019553	1/6/80	USSR		
218	SU1511810	5/26/87	USSR		
219	SU425268	9/27/74	Soviet Union		
220	SU694939	1/7/82	Soviet Union		
221	SU792302	1/2/71	Soviet Union		
222	SU955369	8/30/83	Soviet Union		
223	WO8202617	8/5/82	PCT		
224	WO8502302	5/23/85	PCT		
225	WO9011389	10/4/90	PCT		
226	WO9012409	10/18/90	PCT		
227	WO9101059	1/24/91	PCT		
228	WO9101585	2/7/91	PCT		
229	WO9107807	3/30/91	PCT		
230	WO9109442	6/27/91	PCT		
231	WO8115862	10/17/91	PCT		
232	WO9201328	1/23/92	PCT		
233	WO9203870	3/5/92	PCT		
234	WO9321681	10/28/93	PCT		
235	WO9406194	3/17/94	PCT		
236	WO9518058	7/6/95	PCT		
237	WO9522153	8/17/95	PCT		
238	WO9524049	9/8/95	PCT		

Examiner

Date  
Considered

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

**ALTERNATE FORM PTO-1449**  
**(Corrected Listing of Original List)**

239	WO9622606	7/25/96	PCT		
240	WO9622607	7/25/96	PCT		
241	WO9630144	10/3/96	PCT		
242	WO9710640	3/20/97	PCT		
243	WO9711831	4/3/97	PCT		
244	WO9716881	5/9/97	PCT		
245	WO9745288	12/4/97	PCT		
246	WO9745847	12/4/97	PCT		
247	WO9745848	12/4/97	PCT		
248	WO9745906	12/4/97	PCT		
249	WO9745907	12/4/97	PCT		
250	WO9745912	12/4/97	PCT		
251	WO9745914	12/4/97	PCT		
252	WO9745915	12/4/97	PCT		
253	WO9745916	12/4/97	PCT		
254	WO9745918	12/4/97	PCT		
255	WO9745919	12/4/97	PCT		
256	WO9745920	12/4/97	PCT		
257	WO9745921	12/4/97	PCT		
258	WO9745922	12/4/97	PCT		
259	WO9745923	12/4/97	PCT		
260	WO9745924	12/4/97	PCT		
261	WO9745925	12/4/97	PCT		
262	WO9745926	12/4/97	PCT		
263	WO9745927	12/4/97	PCT		
264	WO9745928	12/4/97	PCT		
265	WO9745929	12/4/97	PCT		
266	WO9745930	12/4/97	PCT		
267	WO9745931	12/4/97	PCT		
268	WO9745932	12/4/97	PCT		
269	WO9745933	12/4/97	PCT		
270	WO9745934	12/4/97	PCT		
271	WO9745935	12/4/97	PCT		
272	WO9745936	12/4/97	PCT		
273	WO9745937	12/4/97	PCT		
274	WO9745938	12/4/97	PCT		
275	WO9745939	12/4/97	PCT		
276	WO9747067	12/11/97	PCT		
277	WO9820595	5/14/98	PCT		
278	WO9820596	5/15/98	PCT		
279	WO9820597	5/14/98	PCT		
280	WO9820600	5/14/98	PCT		
281	WO9821385	5/22/98	PCT		
282	WO9827634	6/25/98	PCT		
283	WO9827635	6/25/98	PCT		
284	WO9827636	6/25/98	PCT		
285	WO9829927	7/9/98	PCT		
286	WO9829928	7/9/98	PCT		
287	WO9829929	7/9/98	PCT		
288	WO9829930	7/9/98	PCT		
289	WO9829931	7/9/98	PCT		

Examiner

Date  
Considered

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

**ALTERNATE FORM PTO-1449**  
**(Corrected Listing of Original List)**

290	WO9829932	7/9/98	PCT		
291	WO9833731	8/6/98	PCT		
292	WO9833736	8/6/98	PCT		
293	WO9833737	8/6/98	PCT		
294	WO9834238	8/6/98	PCT		
295	WO9834240	8/6/98	PCT		
296	WO9834241	8/6/98	PCT		
297	WO9834242	8/6/98	PCT		
298	WO9834243	8/6/98	PCT		
299	WO9834244	8/6/98	PCT		
300	WO9834245	8/6/98	PCT		
301	WO9834246	8/6/98	PCT		
302	WO9834247	8/6/98	PCT		
303	WO9834248	8/6/98	PCT		
304	WO9834249	8/6/98	PCT		
305	WO9834250	8/6/98	PCT		
306	WO9834309	8/6/98	PCT		
307	WO9834312	8/6/98	PCT		
308	WO9834315	0/6/98	PCT		
309	WO9834321	8/6/98	PCT		
310	WO9834322	8/6/98	PCT		
311	WO9834323	8/6/98	PCT		
312	WO9834325	8/6/98	PCT		
313	WO9834326	8/6/98	PCT		
314	WO9834327	8/6/98	PCT		
315	WO9834328	8/6/98	PCT		
316	WO9834329	8/6/98	PCT		
317	WO9834330	8/6/98	PCT		
318	WO9834331	8/6/98	PCT		
319	WO9917309	4/8/99	PCT		
320	WO9917311	4/8/99	PCT		
321	WO9917312	4/8/99	PCT		
322	WO9917313	4/8/99	PCT		
323	WO9917314	4/8/99	PCT		
324	WO9917315	4/8/99	PCT		
325	WO9917316	4/8/99	PCT		
326	WO9917422	4/8/99	PCT		
327	WO9917424	4/8/99	PCT		
328	WO9917425	4/8/99	PCT		
329	WO9917426	4/8/99	PCT		
330	WO9917427	4/8/99	PCT		
331	WO9917428	4/8/99	PCT		
332	WO9917429	4/8/99	PCT		
333	WO9917432	4/8/99	PCT		
334	WO9917433	4/8/99	PCT		
335	WO9919963	4/22/99	PCT		
336	WO9919969	4/22/99	PCT		
337	WO9919970	4/22/99	PCT		
338	WO9927546	6/3/99	PCT		
339	WO9928919	6/10/99	PCT		
340	WO9928921	6/10/99	PCT		

Examiner

Date  
Considered

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

**ALTERNATE FORM PTO-1449**  
**(Corrected Listing of Original List)**

	341	WO9928923	6/10/99	PCT		
	342	WO9928924	6/10/99	PCT		
	343	WO9928925	6/10/99	PCT		
	344	WO9928926	6/10/99	PCT		
	345	WO9928927	6/10/99	PCT		
	346	WO9928928	6/10/99	PCT		
	347	WO9928929	6/10/99	PCT		
	348	WO9928930	6/10/99	PCT		
	349	WO9928931	6/10/99	PCT		
	350	WO9928934	6/10/99	PCT		
	351	WO9928994	6/10/99	PCT		
	352	WO9929005	6/10/99	PCT		
	353	WO9929008	6/10/99	PCT		
	354	WO9929011	6/10/99	PCT		
	355	WO9929012	6/10/99	PCT		
	356	WO9929013	6/10/99	PCT		
	357	WO9929014	6/10/99	PCT		
	358	WO9929015	6/10/99	PCT		
	359	WO9929016	6/10/99	PCT		
	360	WO9929017	6/10/99	PCT		
	361	WO9929018	6/10/99	PCT		
	362	WO9929019	6/10/99	PCT		
	363	WO9929020	6/10/99	PCT		
	364	WO9929021	6/10/99	PCT		
	365	WO9929022	6/10/99	PCT		
	366	WO9929024	6/10/99	PCT		
	367	WO9929026	6/10/99	PCT		
	368	WO9929029	6/10/99	PCT		
	369	WO9929034	6/10/99	PCT		
<b>Subtotal:</b>	<b>369</b>					

**OTHER REFERENCES (Including Title, Author, Date, Pertinent Pages, etc.)**

1	OD001	Shipboard Electrical Insulation; G. L. Moses, 1951, pp2&3
2	OD002	ABB Elkrafthandbok; ABB AB; 1988 ; pp274-276
3	OD003	Elkraft teknisk Handbok, 2 Elmaskiner; A. Alfredsson et al; 1988, pp 121-123
4	OD004	High Voltage Cables in a New Class of Generators Powerformer; M. Leijon et al; 6/14/99; pp1-8.
5	OD005	Ohne Tranformator direkt ins Netz; Owman et al, ABB, AB; 2/8/99; pp48-51
6	OD006	Submersible Motors and Wet-Rotor Motors for Centrifugal Pumps Submerged in the Fluid Handled; K.. Bienick, KSB; 2/25/88; pp9-17
7	OD007	High Voltage Generators; G. Beschastnov et al; 1977; Vol 48. No. 6 pp1-7
8	OD008	Eine neue Type von Unterwassermotoren; Electrotechnik und Maschinenbam, 49; 8/1931; pp2-3
9	OD009	Problems in design of the 110-500kV high-voltage generators; Nikiti et al; World Electrotechnical Congress; 6/21-27/77; Section 1. Paper #18
10	OD010	Manufacture and Testing of Roebel bars; P. Marti et al; 1960, Pub.86, Vol 8, pp 25-31
11	OD011	Hydroalternators of 110 to 220 kV Elektrotechn. Obz., Vol. 64, No. 3, pp132-136 March 1975; A. Abramov

Examiner

Date  
Considered

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

**ALTERNATE FORM PTO-1449**  
 (Corrected Listing of Original List)

	12	OD012	Design Concepts for an Amorphous Metal Distribution Transformer; E. Boyd et al; IEEE 11/84
	13	OD013	Neue Wege zum Bau zweipoliger Turbogeneratoren bis 2 GVA, 60kV Elektrotechnik und Maschinenbau Wien Janner 1972, Heft 1, Seite 1–11; G. Aichholzer
	14	OD014	Optimizing designs of water-resistant magnet wire; V. Kuzenev et al; Elektrotehnika, Vol 59, No 12, pp35-40, 1988
	15	OD015	Zur Entwicklung der Tauchpumpenmotoren; A. Schanz; KSB, pp19-24
	16	OD016	Direct Generation of alternating current at high voltages; R. Parsons; IEEE Journal, Vol 67 #393, 1/15/29; pp1065-1080
	17	OD017	Stopfbachslose Umwalzpumpen- ein wichtiges Element im modernen Kraftwerkbau; H. Holz, KSB 1, pp13-19, 1960
	18	OD018	Zur Geschichte der Brown Boveri-Synchron-Maschinen; Vierzig Jahre Generatorbau; Jan-Feb 1931 pp15-39
	19	OD019	Technik und Anwendung moderner Tauchpumpen; A. Heumann; 1987
	20	OD020	High capacity synchronous generator having no tooth stator, V.S. Kildishev et al; No.1, 1977 pp11-16.
	21	OD021	Der Asynchronmotor als Antrieb stopfbachsloser Pumpen; E. Picmaus; Eletrotechnik und Maschinenbau No. 78, pp153-155, 1961
	22	OD022	Low core loss rotating flux transformer; R. F. Krause, et al; American Institute Physics J.Appl.Phys Vol 64 #10 11/1988, pp5376-5378
	23	OD023	An EHV bulk Power transmission line Made with Low Loss XLPE Cable; Ichihara et al; 8/92; pp3-6
	24	OD024	Underground Transmission Systems Reference Book; 1992; pp16-19; pp36-45; pp67-81
	25	OD025	Power System Stability and Control; P. Kundur, 1994; pp23-25; page 767
	26	OD026	Six phase Synchronous Machine with AC and DC Stator Connections, Part II: Harmonic Studies and a proposed Uninterruptible Power Supply Scheme; R. Schiferl et al.; 8/1983 pp 2694-2701
	27	OD027	Six phase Synchronous Machine with AC and DC Stator Connections, Part 1: Equivalent circuit representation and Steady-State Analysis; R. Schiferl et al; 8/1983; pp2685-2693
	28	OD028	Reactive Power Compensation; T. Petersson; 1993; pp 1-23
	29	OD030	Permanent Magnet Machines; K. Binns; 1987; pp 9-1 through 9-26
	30	OD031	Hochspannungsanlagen für Wechselstrom; 97. Hochspannungsaufgaben an Generatoren und Motoren; Roth et al; 1938; pp452-455
	31	OD032	Hochspannungsanlagen für Wechselstrom; 97. Hochspannungsaufgaben an Generatoren und Motoren; Roth et al; Spring 1959, pp30-33
	32	OD033	Neue Lösungswägen zum Entwurf grosser Turbogeneratoren bis 2GVA, 60kV; G. Aichholzer; 9/1974, pp249-255
	33	OD034	Advanced Turbine-generators- an assessment; A. Appleton, et al; International Conf. Proceedings, Lg HV Elec. Sys. Paris, FR, Aug-Sept/1976, Vol I, Section 11-02, pg1-9
	34	OD035	Fully slotless turbogenerators; E. Spooner; Proc., IEEE Vol 120 #12, 12/1973
	35	OD036	Toroidal winding geometry for high voltage superconducting alternators; J. Kirtley et al; MIT – Elec. Power Sys. Engrg. Lab for IEEE PES; 2/1974
	36	OD037	High-Voltage Stator Winding Development; D. Albright et al; Proj. Report EL339, Project 1716, April 1984
	37	OD038	POWERFORMER™: A giant step in power plant engineering; Owman et al; CIGRE 1998, Paper 11:1.1
	38	OD039	Thin Type DC/DC Converter using a coreless wire transformer; K. Onda et al; Proc. IEEE Power Electronics Spec. Conf.; 6/1994, pp330-334
	39	OD040	Development of extruded polymer insulated superconducting cable; 1/1992
	40	OD041	Transformer core losses; B. Richardson; Proc. IEEE 5/1986, pp365-368

Examiner

Date  
Considered

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

**ALTERNATE FORM PTO-1449**  
**(Corrected Listing of Original List)**

	41	OD042	Cloth-transformer with divided windings and tension annealed amorphous wire; T. Yammamoto et al; IEEE Translation Journal on Magnetics in Japan Vol 4, No. 9 Sept. 1989
	42	OD043	A study of equipment sizes and constraints for a unified power flow controller; J Bian et al; IEEE 1996
<b>Subtotal</b>	<b>43</b>		
<b>GRAND TOTAL</b>	<b>671</b>		

Examiner

Date  
Considered

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

09/509428



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

430 Rec'd PCT/PTO 28 MAR 2000

TJL  
2/3/99

RESPONSE TO DECISION  
2-1-00

Paper No. 11

Oblon Spivak McClelland Maier & Neustadt  
1755 Jefferson Davis Highway  
Fourth Floor  
Arlington VA 22202

COPY MAILED

DEC 01 1999

SPECIAL PROGRAMS OFFICE  
DAB FOR PATENTS

In re Application of  
Mats Leijon, et al  
Application No. 09/147,325  
Filed: February 17, 1999  
Attorney Docket No. 9847-0001-  
6X

: RESPONSE TO PETITION UNDER  
: 37 CFR 1.182 SEEKING SPECIAL  
: TREATMENT RELATING TO AN  
: ELECTRONIC SEARCH TOOL, AND  
: DECISION ON PETITION UNDER  
: 37 CFR 1.183 SEEKING WAIVER  
: OF REQUIREMENTS UNDER 37 CFR  
: 1.98

This is a response to a September 29, 1999 Petition Under 37 CFR 1.182, requesting relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98 in view of the need to file multiple applications relating to different aspects of a particular invention. The petition will be treated as two separate petitions: a first petition under 37 CFR 1.182, relating to submission of an electronic search tool and the need to protect proprietary information therein, and a second petition under 37 CFR 1.183, requesting relief from the § 1.98 provision which requires filing paper copies of references being cited in each of many related applications.

A Decision on the petition under 37 CFR 1.182 re the electronic search tool will be issued in due course.

The petition under 37 CFR 1.183 re the submission of 3 paper copies of IDS citations in a holding application is Granted to the extent set forth below.

The Decision is set forth in five parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.182 - Electronic Search Tool
- Part III. Petition Under 37 CFR 1.183 - Paper Copies

RECEIVED  
DEC 03 1999

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT P.C.

- Part IV. Summary
- Part V. Further Correspondence

Part I. Background

The instant national stage application filed under 35 U.S.C. 371 currently contains claims 77-153 with three independent claims. The instant application is one of about 200 U.S. applications (either filed or to be filed) with each U.S. application having as many as 40 corresponding foreign applications (either filed or to be filed), the applications relating to different aspects of the invention. An Information Disclosure Citation List has been submitted that lists 259 U.S. patents, 369 foreign patent documents, and 43 other references for a total of 671 citations. Additionally, a list of related cases has been supplied containing 31 U.S. applications and 52 PCT applications. Paper copies have not been supplied in the related applications of any of the citations or the identified related cases.

37 CFR 1.56(b)(1) requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98. 37 CFR 1.56(a).

Petitioner asks "[w]hether the information cited in the manner proposed in [petition] Section 3.1.1 ... is a disclosure that is sufficient to meet the requirements of 37 CFR § 1.56." To the extent that this question refers to the content of the disclosure and the particulars of the subject applications, the Office will not answer the question. It is Office practice not to attempt to define how an individual "ensures" compliance with the rule in a particular application. See, e.g., MPEP 2004. Because determinations on this issue require an evaluation of the intent of the party involved, the Office declines to investigate the question. See MPEP 2010. To the extent that Petitioner's question concerns the form in which the disclosure is provided, rule 56 permits a disclosure in a combination of paper and electronic formats.

Petitioner, in addition to meeting the duty set forth in 37 CFR 1.56 to disclose material information, also wishes to disclose to the Office information that may not meet the definition of

materiality as set forth in the rule<sup>1</sup>. Information identified by U.S. or foreign examiners in any of the related U.S. and foreign applications would be cited in each of the related U.S. applications.<sup>2</sup> In addition, Petitioner seeks to submit other information in each of the related U.S. applications, such as all the co-pending U.S. applications that relate to the invention (useful for determining possible double patenting rejections), and foreign search reports. Petition, page 4.

Rather than be required to submit, via a paper copy, each piece of information in each application each time the information is obtained, Petitioner seeks to have:

- (1) (a) one application (the instant application) identified as a "holding" application which would contain a complete set of paper copies of references; the paper copies to be submitted in only the "holding" application;
- (b) the other related pending U.S. applications, hereafter referred to as the bulk filing applications, will not contain the paper set of reference copies but will contain other information, e.g., a copy of the decision on petition<sup>3</sup> permitting such procedure and a copy of the Form 1449 (or equivalent);<sup>4</sup> and
- (2) an "electronic search tool"<sup>5</sup> containing different types of information.

The information supplied via the paper copies would be updated monthly, rather than as received from U.S. and foreign examiners, and cancellation of this arrangement would be an option for both

---

<sup>1</sup>Reference to MPEP 2001.05, Petition, page 3.

<sup>2</sup>Petition, page 3. The present petition requesting relief does not set forth any commitment nor intent by applicant to screen such information for relevancy to each of the U.S. applications in which the information is being cited.

<sup>3</sup>The original of which would be in the instant holding application.

<sup>4</sup>See, Petition under 37 CFR 1.182, *infra*.

<sup>5</sup>See, Petition under 37 CFR 1.183, *infra*.

Petitioner and the Office upon notice. These, and other more specific conditions, are discussed in further detail in regard to the § 1.182 petition, below.

Petitioner has essentially requested relief in two areas: (1) treatment of information in an electronic search tool, to be submitted independent of any particular application, as in compliance with IDS submission requirements for all bulk filing applications, and (2) the ability to provide the paper copies of each reference in an IDS submission in only one of the bulk filing applications (the instant holding application) as well as two additional sets of copies rather than as is normally required in each application for which the reference (IDS citation) is to be considered. These two areas of relief are independent of each other and drawn toward different regulations. Accordingly, the petition has been treated as two petitions, and the present decision addresses the two areas of requested relief separately. While it is undeniable that relief in both areas would be of benefit to Petitioner, the granting of relief in one area does not, in fact, require the granting of relief in the other. Moreover, in view of the need to further consider the requested relief related to the electronic search tool, deciding the requested relief issues separately permits at this time a partial grant of the original petition.<sup>6</sup>

Part II. Petition under 37 CFR 1.182- Electronic Search Tool

The issues involving the electronic search tool are more extensive than those relating to the requirement for paper copies in each bulk filing application and more time is needed to fully consider and address them. Accordingly, the petition under § 1.182 shall not be decided at this time and is not treated in the instant decision on the § 1.183 petition although it will continue to be considered, with a decision rendered in due course.

---

<sup>6</sup>It is recognized that petitioner believes the issues presented by the petition may not be decided independent of one another as both the paper copy issue and the electronic search tool issue represent the most complete solution to duty ~~of~~ disclosure issues under 37 CFR 1.56, Petition, fn. 5. :-

Part III. Petition Under 37 CFR 1.183 - Paper Copies

The submitted petition fee of \$130 will be treated as the \$ 1.183 petition fee.

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, page 600-102, right-hand column, and page 600-103, left-hand column.

Paper copies: Petitioner notes that the instant application is one of 200 bulk filing applications that will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each reference, brought to the attention of the Office in regard to any one individual application, not be required to be submitted in each such application. Rather, it is requested that three complete sets of paper copies be permitted to be filed: one set for the instant application which will be designated as a holding application; one set to be used to establish new subclasses for the technology; and one set to be used as a reference set should either or both of the other two sets become corrupted (Petition, pages 6 and 7).<sup>7</sup>

Once past the initial IDS submission, it is proposed that applicant would update the IDS submissions once a month, rather than every time a new reference is found, although the time frames required by S 1.97 would have to be complied with, which may mean that submissions may occur more frequently than once a month.

Form 1449: In addition to submission of the three sets of paper copies in the instant "holding" application, the petition proposes that each of the bulk filing applications would receive a Form 1449 listing the reference citations (Petition, page 7) and the Form 1449 (in each of the bulk filing applications) would be updated, pursuant to the time requirements of S 1.97, each time the three sets of paper copies are updated. The petition is

---

<sup>7</sup>It would presumably up to the Technology Center to determine how best to store the reference set and how it is to be accessed.

silent as to whether other types of information that may be submitted in the holding application IDS, e.g., concise explanations of foreign language documents under § 1.98(a)(3), would also be supplied in all the bulk filing applications.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies), the petition states that upon allowance of the instant holding application the right is reserved to file a petition to suspend action in the instant application so that the application can remain as the holding application (Petition, page 7). Alternatively, upon agreement of the Assignee and a Director of the Technology Center involved, an alternate application may be designated as the holding application.

New subclasses: The petition envisions an affirmative duty on the Technology Center to establish new subclasses that will include each of the references submitted during the course of prosecution of the bulk filing applications.<sup>8</sup> In addition, the Office is to agree that "[e]xaminers will be required to search these newly created subclasses" (from submissions by the Assignee and later by others) "as part of the routine patent prosecution process." Petition, page 8.

Termination: Petitioner seeks a right of termination,<sup>9</sup> which is to be a mutual option. Termination is to be by written notice, to the attorney of record if the Office terminates and the filing of a termination request and by contacting the Director of TC 2800 if applicant terminates. Conventional IDS procedures would begin three months after notice of termination.

---

<sup>8</sup>The new subclasses will later be supplemented by references supplied by others who may file applications related to the same technology.

<sup>9</sup>Although termination is discussed under a section related to licensing of the electronic search tool and the petition generally (Petition, pages 10 and 11), it is presumed that Petitioner intends to have the termination provision apply to the waiver of paper copies if that alone is granted.

37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of references in 200 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's point of view in terms of making the copies available to different examiners handling the various applications,<sup>10</sup> on balance, there is seen to be sufficient benefit to justify waiver in this instance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.<sup>11</sup>

---

<sup>10</sup>Even though the technology of the applications may be related, the specific claims of the applications may require different classifications of the applications and the quantity of applications would dictate the need for more than one examiner to timely examine the applications.

<sup>11</sup>The waiver being granted in this instance is not intended to set a general precedent where there is more than one application containing related subject matter. The Office, however, intends to use the instant grant to study whether the opportunity for waiver can be extended to other applicants in similar circumstances, and whether a more general program can be announced. One factor that will be considered is the extent to which relevant information (that may not be necessarily required by § 1.56(b) but which would nonetheless be useful to the examiner, e.g., § 1.56(a)(1) and (2)), is submitted rather than huge dumps of nonrelevant or marginally relevant information.

It is noted that while the petition only refers to the submission of citations that are made by both U.S. and foreign examiners, the term "include" is used (Petition, page 2) which is open ended. The Petition states that it is the intention to submit a copy of every reference identified both by U.S. examiners in the 200 U.S. applications and by foreign examiners in as many as 40 corresponding foreign applications for each U.S. application (Petition, page 3). It has not been stated whether the current 671 reference citations currently of record represent only those citations made by U.S. and foreign examiners or whether they include citations from other sources, such as a

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing application provided that the following <sup>8</sup> conditions are complied with:

- 1) Three paper copies of each IDS citation are or have been submitted to the Office;
- 2) The (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;
- 3) The information is or has also been cited in the holding application;

**Note:** Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

- 4) A copy of this Decision is filed in the bulk filing application;
- 5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.
- 6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would

---

preexamination search or third party citations. See also Petition, page 19.

have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

- 7) The grant of the § 1.183 petition re § 1.98(a)(2) does not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications,<sup>12</sup> or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.
- 8) The Office has established a series of Official Digests in Class 174 based on the technology represented by the instant invention (a classification schedule thereof is attached). As is the case will all Digests, their usefulness will be continually evaluated. The Office will place the holding application's references in the Digests as they are determined to require such placement and as new ones are brought to the attention of the Office either by Petitioner or a third party. A search of the Digests themselves or what they contain (such as the holding application or reference copy sets), either in paper copy or electronic form, will be

---

<sup>12</sup>The patent file can be kept in the Technology Center for easy reference, or rather than rely upon the patent, either the reference set of paper copies could be utilized, or the Office may decide to rely on the Digests being created.

conducted when mandatory based on the classification of the claims, or when deemed advisable - on a case by case basis.

Part IV. Summary

A Decision on the Petition under 37 CFR 1.182, drawn toward submission of the electronic search tool, will be acted upon in due course when all outstanding issues are resolved.

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted, however, the following is not agreed to:

- the grant of a future petition under 37 CFR 1.103 for suspension from publication of the holding application should it be allowed,
- the required search of subclasses from one of the three sets of paper copies and placement of one of the other sets of paper copies therein, and
- any termination provision more than two months (rather than the three months that the petition sets forth) from notice of termination.

Part V. Further Correspondence

Further correspondence with respect to this matter should be addressed to Hiram H. Bernstein, Senior Legal Advisor, Special Program Law Office, as follows:

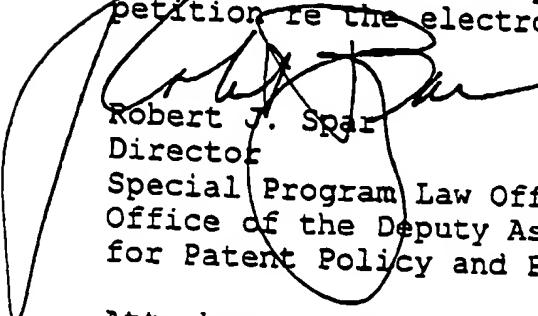
By mail:      Commissioner of Patents and Trademarks  
                  Box DAC  
                  Washington, D.C. 20231

By FAX:      (703) 308-6916  
                  Attn: Special Program Law Office

By hand:      Special Program Law Office  
                  Crystal Plaza Four, Suite 3C23  
                  2201 South Clark Place  
                  Arlington, VA 22202

Telephone inquiries specific to this matter should be directed to Mr. Bernstein at (703) 305-9285.

The instant application will be retained by this Office: for a period of TWO MONTHS to await any response to the instant Decision, and for the purpose of continuing review of the S 1.182 petition re the electronic search tool.

  
Robert J. Spar  
Director  
Special Program Law Office  
Office of the Deputy Assistant Commissioner  
for Patent Policy and Projects

Attachment: List of Digests 13-33

- Digest 13 HIGH VOLTAGE CABLE (E.G., ABOVE 10KV, CORONA PREVENTION, ETC.)
- Digest 14 . Having a particular cable application (e.g., winding, etc.)
- Digest 15 .. In a power generation system (e.g., prime-mover dynamo, generator system, etc.)
- Digest 16 .. In a motive power system (e.g., electric motor control system, etc.)
- Digest 17 .. In an electric power conversion, regulation, or protection system
- Digest 18 .. In a power distribution network
- Digest 19 .. In a dynamo-electric machine
- Digest 20 ... Stator
- Digest 21 ... Rotor
- Digest 22 ... Winding, per se
- Digest 23 .. In a circuit breaker, relay, or switch
- Digest 24 .. In an inductive device (e.g., reactor, electromagnet, etc.)
- Digest 25 ... Transformer
- Digest 26 . Having a plural-layer insulation system
- Digest 27 .. Including a semiconductive layer
- Digest 28 ... Plural semiconductive layers
- Digest 29 . Having a semiconductive layer
- Digest 30 . Having insulation with a particular dimension or geometry
- Digest 31 . Having a shield or metallic layer
- Digest 32 . Having means for cooling
- Digest 33 . Method of cable manufacture, assembly, repair, or splicing